

ATTORNEY DOCKET NO. 12790STUS01U (NORT10-00090)
U.S. SERIAL NO. 09/737,592
PATENT

REMARKS

Claims 1-24 and 27 are pending in the application.

Claims 1-24 and 27 have been rejected.

Claim 27 has been amended.

I. REJECTION UNDER 35 U.S.C. § 102

Claim 27 was rejected under 35 U.S.C. § 102(e) as being anticipated by Baxter, Jr. (US 6,385,306). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claim 27 has been amended to recite "converting and compressing said received voice message from said first file format to a second file format to generate a compressed audio portion" and "generating a message file in said second file format, said message file comprising said compressed audio portion and an information portion stored in one or more text fields provided for in said second file format" See, amended Claim 27.

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Baxter, Jr. recites:

... The voice message is compressed and encoded into a digital audio file 40 and then attached to the email address previously identified 110 . The email and digital audio file attachment is then opened and listened to by the recipient 260. . .
. Col. 10, lines 19-23.

This passage (and Figure 6) describes that the voice message (audio) is compressed and sent via email (to the email address previously input or designated by the user generating the voice message) as an email attachment. Baxter, Jr. appears to compress the recorded voice message into a digital audio file which is then sent via email to an email address. No information portion, other than the compressed audio portion, is included in Baxter's compressed digital audio file. The email address provides a destination address for the email (with attached file) and the email address is not provisioned in the second file format (i.e., the compressed audio file format). Baxter, Jr. fails to disclose that the compressed message file (in the second file format) includes both a compressed audio portion and an information portion.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claim 27.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-9 and 15-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) in view of Baxter, Jr. (US 6,385,306). Claims 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) as applied to claim 1 above, and further in view of Luzeski, et al. (US 6,301,245). The rejections are respectfully traversed.

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In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

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the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

For the reasons set forth above with respect to the 102 rejection based upon Baxter, Jr., the independent Claims 1, 23 and 24 (method, computing device and computer readable medium) include elements/feature not disclosed, taught or suggested by Baxter, Jr., Helfrich and/or Luzeski. None of the references recite that the received voice message file is in the compressed file format, and the file comprises both a compressed audio portion and an information portion.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-24.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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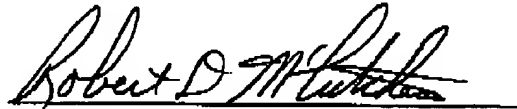
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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